



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re Application of:	)	
Paul C. Coffin, et al.	)	
Serial No.: 09/624,798	)	Confirmation No.: 6517
Filing Date: 07/24/2000	)	Examiner: J. A. Watko
For: RECONFIGURABLE CARTRIDGE	)	
PROCESSING MODULE FOR STORING	)	Group Art Unit: 2652
CARTRIDGE RECEIVING DEVICES IN	)	
A DATA STORAGE SYSTEM	)	
Docket No.: 10001664-1	)	

#### CERTIFICATE OF MAILING

I hereby certify that the attached **Transmittal Letter for Response/Amendment (in duplicate); Request for Reinstatement of Appeal under 37 CFR Section 1.193 (b) (2) (ii); Supplemental Appeal Brief in triplicate (23 pages including Table of Contents, Table of Authorities, and Appendices A and B); Two- (2) reference documents; and Post cards for return by the United States Patent and Trademark Office**, are all being deposited with the United States Postal Service addressed to the Commissioner for Patents, Mail Stop Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, via first class mail, on this 19th day of October 2004.

By:   
Bruce E. Dahl, Reg. No. 33,670



IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Paul C. Coffin, et al.

Confirmation No.: 6517

Application No.: 09/624,798

Examiner: J. A. Watko

Filing Date: 07/24/2000

Group Art Unit: 2652

Title: RECONFIGURABLE CARTRIDGE PROCESSING MODULE FOR STORING CARTRIDGE  
RECEIVING DEVICES IN A DATA STORAGE SYSTEM

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Mail Stop Amendment  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ( ) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
( ) No additional fee  
(X) Other: Request for Reinstatement of Appeal (fee \$                     )

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	17	MINUS	20	= 0	X \$18	\$ 0
INDEP. CLAIMS	4	MINUS	4	= 0	X \$88	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$300	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$430.00	3RD MONTH \$980.00	4TH MONTH \$1530.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.

Respectfully submitted,

Paul C. Coffin, et al.

By

Bruce E. Dahl

Attorney/Agent for Applicant(s)  
Reg. No. 33,670

Date: 10-19-2004

Date of Deposit: 10-19-2004

Typed Name: Bruce E. Dahl

Signature:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: )

COFFIN, Paul, C., et al. )

Serial No. 09/624,798 )

Filing Date: July 24, 2000 )

For: RECONFIGURABLE CARTRIDGE )  
PROCESSING MODULE FOR )  
STORING CARTRIDGE RECEIVING )  
DEVICES IN A DATA STORAGE )  
SYSTEM )

Examiner: Watko, J.A.

Group Art Unit: 2652

Conf. No.: 6517

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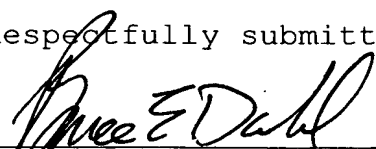
**REQUEST FOR REINSTATEMENT OF APPEAL**  
**UNDER 37 CFR §1.193(b)(2)(ii)**

To: The Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

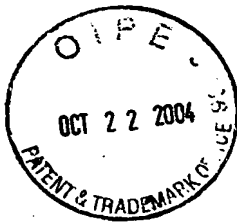
Sir:

In response to the office action, paper number (18), dated July 22, 2004, applicants respectfully request reinstatement of the appeal pursuant to 37 CFR 1.193(b)(2)(ii). Applicants submit herewith a Supplemental Appeal Brief.

Respectfully submitted,

  
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Date: 10-19-04



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:	)	
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COFFIN, Paul, C. et al.	)	Examiner: Watko, J.A.
	)	
Serial No. 09/624,798	)	
	)	Group Art Unit: 2652
Filing Date: July 24, 2000	)	
	)	
For: RECONFIGURABLE CARTRIDGE	)	
PROCESSING MODULE FOR STORING	)	Confirmation No.: 6517
CARTRIDGE RECEIVING DEVICES IN	)	
A DATA STORAGE SYSTEM	)	
	)	
Atty Dkt: 10001664-1	)	

**SUPPLEMENTAL APPEAL BRIEF**

Bruce E. Dahl\*  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of: )  
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COFFIN, Paul, C. et al. ) Examiner: Watko, J.A.  
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Serial No. 09/624,798 )  
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A DATA STORAGE SYSTEM )  
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Atty Dkt: 10001664-1 )

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**SUPPLEMENTAL APPEAL BRIEF**

**Technology Center 2600**

To: Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Supplemental Appeal Brief is submitted in response to the rejections of the claims contained in the non-final office action dated July 22, 2004 (referred to herein as "Office Action"), which re-opened prosecution. A request for reinstatement of appeal under 37 CFR 1.197(b)(2)(ii) is filed concurrently herewith.

**REAL PARTY-IN-INTEREST**

Appellants specifically incorporate herein by reference the corresponding section in the Appeal Brief, filed March 12, 2004.

### **RELATED APPEALS AND INTERFERENCES**

Appellants specifically incorporate herein by reference the corresponding section in the Appeal Brief, filed March 12, 2004.

### **STATUS OF THE CLAIMS**

Claims 1-6 and 10-20 are pending in the application. Claims 1-6 and 10-20 currently stand rejected. The rejections of claims 1-6 and 10-20 are appealed.

### **STATUS OF AMENDMENTS**

Appellants specifically incorporate herein by reference the corresponding section in the Appeal Brief, filed March 12, 2004. On July 22, 2004, the examiner re-opened prosecution and issued the Office Action dated July 22, 2004. No amendments were filed or entered subsequent to the office action of July 22, 2004.

### **SUMMARY OF INVENTION**

Appellants specifically incorporate herein by reference the corresponding section in the Appeal Brief, filed March 12, 2004.

### **ISSUES**

1. Whether claims 1, 2, 4, 5, 14, 15, 17, 19, and 20 are unpatentable under 35 U.S.C. §102(b) as being anticipated by Pilgrim, *Build Your Own 486/486DX*, McGraw-Hill, Inc., New York, 1995) (Pilgrim).

2. Whether claims 6, 10, 11, 13, and 16 are unpatentable under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Pilgrim.



3. Whether claims 3, 12, and 18 are unpatentable under 35 U.S.C. §103(a) as being obvious over Pilgrim in view of Menke, *et al.*, U.S. Patent No. 5,841,744 (Menke).

### **GROUPING OF THE CLAIMS**

With respect to the anticipation rejections under 35 U.S.C. §102, claims 1, 2, 10, 14, and 20 are independently patentable, as set forth in the Argument. Claims 4-6 stand or fall with claim 1, claims 11 and 13 stand or fall with claim 10, and claims 15-17 and 19 stand or fall with claim 14. With respect to the obviousness rejections under 35 U.S.C. §103, claims 3, 6, 10, 16, and 18 are independently patentable, as set forth in the Argument. Claims 11-13 stand or fall with claim 10.

### **ARGUMENT**

#### **Opening Statement**

The examiner's anticipation rejections are improper in that Pilgrim fails to meet each and every limitation of the pending claims. In addition, the Pilgrim reference is non-enabling, thus unable to support an anticipation rejection under Section 102. The obviousness rejections are improper in that neither Pilgrim nor Menke provide the suggestion or incentive required to modify the references in a manner that would make obvious the pending claims. Therefore, the examiner has failed to establish the required *prima-facie* case of obviousness.

**ISSUE 1: Whether claims 1, 2, 4, 5, 14, 15, 17, 19, and 20 are unpatentable under 35 U.S.C. §102(b) as anticipated by Pilgrim.**

#### **Legal Standard For Rejecting Claims** **Under 35 U.S.C. §102(b)**

The standard for lack of novelty, that is, for “anticipation,” under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991). Furthermore, functional language, preambles, and language in “whereby,” “thereby,” and “adapted to” clauses cannot be disregarded. *Pac-Tec, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

### **The Examiner’s Rejections**

The examiner rejected claims 1, 2, 4, 5, 14, 15, 17, 19, and 20 as being anticipated by Pilgrim. The examiner’s rejections are improper because Pilgrim fails to disclose each and every limitation in the rejected claims. In addition, the Pilgrim reference is non-enabling with respect to the structure specifically defined by the claims, thus not available to support an anticipation rejection.

Claim 1 is directed to a “reconfigurable cartridge processing module” comprising a frame that defines first and second component configurations. In the first component configuration, first and second cartridge receiving devices together occupy “a volumetric space within said frame.” In the second component configuration, a third cartridge receiving device occupies “substantially the same volumetric space within said frame as is occupied by said first and second cartridge receiving devices in said first component configuration.”

In supporting her rejections, the examiner asserts that the first and second cartridge receiving devices of claim 1 are met by a “3½ inch floppy drive” and a “5¼ floppy drive,” respectively. The examiner then asserts that the third cartridge receiving device of claim 1 is met

by the “old 360k floppy disk drive.” See page 3 of the office action. The office action is not clear as to whether the 3½” and 5¼” floppy drives are individual drives, or whether they comprise portions of the combination drive or “combo” drive. The Pilgrim reference discloses both types of drives. However, Pilgrim does not anticipate in either case.

In the first case, i.e., where the 3½” and 5¼” floppy drives are individual drives, Pilgrim fails to meet at least the limitation of claim 1 that requires that the third cartridge receiving device occupy “substantially the same volumetric space” within the frame as occupied by the first and second cartridge receiving devices. That is, when the 3½” and 5¼” floppy drives are replaced with the “old 360k floppy drive,” the old 360k floppy drive will occupy *only half* of the volumetric space as was occupied by the 3½” and 5¼” drives, not “substantially the same volumetric space” as required by claim 1.

In the second case, i.e., where the 3½” and 5¼” floppy drives comprise the combination drive, Pilgrim fails to meet the limitation of claim 1 that requires that the first and second cartridge receiving devices be mounted to respective first and second sets of the plurality of sets of mounting locations provided on the frame. Pilgrim states that the “combination drive requires only a single drive bay.” Therefore, the combination drive of Pilgrim would mount to but a single set of mounting locations, not respective first and second sets of mounting locations for the corresponding first and second cartridge receiving devices as required by claim 1. Stated another way, because the two drives are mounted in a single housing in the “combo” configuration, there is no need for a mounting arrangement wherein the two drives would somehow be separately mounted to respective first and second sets of mounting locations, as required by claim 1.

Therefore, Pilgrim fails to meet the limitations of claim 1 regardless of whether the 3½” and 5¼” floppy drives are considered to be separate drives or parts of a combination drive. If the drives are separate, they fail to meet the “volumetric space” limitation of claim 1. If they

comprise a combination unit, they fail to meet the “first and second sets of mounting locations” limitation of claim 1.

In addition, Pilgrim cannot anticipate claim 1 because it is non-enabling, and a non-enabling reference is not prior art and cannot anticipate a claim under Section 102. See *Helifix Ltd. v Blok-Lok, Ltd.* 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000). In *Helifix*, the Court of Appeals for the Federal Circuit found a product brochure to be non-anticipating under Section 102 because it failed to contain detail sufficient to allow a person having ordinary skill in the art to have made or obtained a tool capable of being used in the claimed method without undue experimentation.

Claim 1 recites, among other elements, a frame having a lower plate and an upper plate positioned in generally parallel, spaced-apart relation and having a plurality of sets of mounting locations provided thereon so that the frame defines first and second component configurations. While the examiner asserts on page 2 of the office action that the frame is illustrated in Figure 11-13 of the Pilgrim reference, that illustration is captioned “A large desktop case. Note the raised channels and slots.” The caption makes no reference to a frame, much less a frame comprising upper and lower plates positioned in generally parallel, spaced-apart relation, as required by claim 1. As reproduced, most of the features illustrated in Figure 11-13 are obliterated, and it is impossible to discern whether Figure 11-13 indeed discloses an upper plate and a lower plate, much less their specific positioning requirements and whether the upper and lower plates have a plurality of sets of mounting locations provided thereon, as also required by claim 1. While the examiner asserts at the top of page 3 that the mounting locations of claim 1 are “bays and parts of bays, for example,” Appellants are unable to discern any bays at all in Figure 11-13. The caption description of Figure 11-13 also fails to contain any reference to the term “bays” or “parts of bays.” In any event, the terms “bays” and “parts of bays” cannot be

reasonably said to be analogous to the mounting locations provided in the upper and lower plates as recited in claim 1.

Because it is well-established law that a reference must be enabling before it can anticipate, and because the Pilgrim reference is non-enabling as to the specific structural elements and arrangements defined by claim 1, Pilgrim cannot anticipate claim 1.

Dependent claim 2 is independently allowable in that Pilgrim fails to disclose a first cartridge receiving device that comprises “a half-width cartridge read/write device.” In supporting her rejections of claim 1, the examiner takes the position that the first cartridge receiving device is the 3½” floppy drive. See page 3 of the office action. Then, on page 6, in specifically addressing claim 2, the examiner takes the position that the first cartridge receiving device comprises the combination drive. It cannot be both. Either the first cartridge receiving device comprises the 3½” floppy drive or the combination drive. Because the examiner asserts that the first cartridge receiving device simultaneously comprises either of two devices, depending on what limitation must be met, the examiner has failed to establish the required *prima-facie* case of anticipation. Therefore, claim 2 is not anticipated by Pilgrim.

Dependent claims 4 and 5 stand or fall with independent claim 1.

Independent claim 14 is allowable because Pilgrim fails to meet at least the limitation of claim 14 that requires that the third cartridge receiving means replace the first and second cartridge receiving means so that a volumetric space occupied by the first and second cartridge receiving means is substantially occupied by the third cartridge receiving means. That is, when the 3½” and 5¼” floppy drives are replaced with the “old 360k floppy drive,” the old 360k floppy drive will only occupy *only half* of the volumetric space as was occupied by the 3½” and 5¼” drives. This arrangement fails to meet the limitation of claim 14, which requires that the volumetric space occupied by the first and second cartridge receiving means be “substantially

occupied” by the third cartridge receiving means.

In addition, Pilgrim cannot anticipate claim 14 because it is non-enabling, and a non-enabling reference is not prior art. *Helifix, supra*. For example, claim 14 recites, among other elements, a frame having a lower plate and an upper plate positioned in generally parallel spaced-apart relation and having a plurality of sets of mounting locations provided thereon so that the frame defines first and second mounting locations. While the examiner asserts on page 4 of the office action that the frame is illustrated in Figure 11-13 of the Pilgrim reference, most of the features of Figure 11-13 are obliterated, and it is impossible to discern whether Figure 11-13 indeed discloses a frame that comprises an upper plate and a lower plate, much less their specific positioning requirements, and whether the upper and lower plates have a plurality of sets of mounting locations provided thereon. While the examiner asserts on page 4 that the mounting locations of claim 14 are “bays and parts of bays, for example,” Appellants are unable to discern any bays at all in Figure 11-13. The caption of Figure 11-13 also fails to contain any reference to the term “bays” or “parts of bays.”

Because a reference must be enabling before it can anticipate, and because the Pilgrim reference is non-enabling as to the specific structural elements and arrangements defined by claim 14, Pilgrim cannot anticipate claim 14.

Dependent claims 15, 17, and 19 stand or fall with independent claim 14.

Independent claim 20 is allowable in that Pilgrim fails to disclose the method defined by claim 20. First, Pilgrim fails to disclose “providing a frame having an upper plate and a lower plate positioned in generally parallel, spaced-apart relation” and having a plurality of sets of mounting locations thereon. While the examiner asserts that Figure 11-13 of Pilgrim meets these limitations, Appellants are unable to discern in Figure 11-13 a frame having upper and lower plates, much less a frame that meets the other limitations of claim 20. Indeed, because Pilgrim

is non-enabling as to the structural elements set forth in claim 20, Pilgrim cannot anticipate claim 20 as a matter of law. See, for example, *Helifix, supra*.

In addition, Pilgrim fails to define a “first component configuration” by mounting first and second cartridge receiving devices to respective first and second mounting locations provided on the frame; or, in the alternative, defining a “second component configuration” by mounting a third cartridge receiving device to a third set of mounting locations provided on the frame so that a volumetric space occupied by the first and second cartridge receiving devices is substantially occupied by the third cartridge receiving device, and vice-versa. In supporting her rejections, the examiner asserts that the first and second cartridge receiving devices comprise the 3½” and 5¼” floppy drives, respectively, whereas the third cartridge receiving device comprises the old 360k floppy drive. See page 5 of the office action. However, the volumetric space defined by the 3½” and 5¼” floppy drives when defining the first component configuration is not “substantially occupied” by the old 360k floppy drive” when defining the second component configuration. To the contrary, the old 360k floppy drive (defining the second component configuration) will occupy *only half* of the volumetric space as was occupied by the 3½” and 5¼” drives (defining the first component configuration). Consequently, Pilgrim cannot anticipate claim 20.

If the 3½” and 5¼” floppy drives referred to by the examiner comprise the combination drive, Pilgrim fails to meet the limitation of claim 20 that requires that the first and second cartridge receiving devices be mounted to respective first and second sets of the plurality of sets of mounting locations provided on the frame. Pilgrim states that the “combination drive requires only a single drive bay.” Therefore, the combination drive of Pilgrim would mount to but a single set of mounting locations, not respective first and second sets of mounting locations for the corresponding first and second cartridge receiving devices as required by claim 20. Stated another way, because the two drives are mounted in a single housing in the “combo”

configuration, there is no need for a mounting arrangement wherein the two drives would somehow be separately mounted to respective first and second sets of mounting locations, as required by the claim.

**ISSUE 2: Whether claims 6, 10, 11, 13, and 16 are unpatentable under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Pilgrim.**

Legal Standard For Rejecting Claims  
Under 35 U.S.C. §103

The legal standard for determining obviousness under Section 103 is set forth in the Appeal Brief and will not be repeated herein. Instead, Appellants specifically incorporate herein by reference the legal standard set forth in the Appeal Brief.

**The Examiner's Rejections**

The examiner rejected claims 6, 10, 11, 13, and 16 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Pilgrim. These rejections are improper in that Pilgrim fails to meet each and every limitation contained in the rejected claims. Pilgrim is also unable to support an anticipation rejection because it is non-enabling of the specific structure set forth in the pending claims. A non-enabling reference cannot anticipate as a matter of law. With regard to the examiner's alternative obviousness rejections, Pilgrim fails to provide the suggestion or incentive that would lead a person having ordinary skill in the art to modify the Pilgrim device in the manner required by the pending claims. Therefore, Pilgrim cannot establish the required *prima-facie* case of obviousness.

With regard to the examiner's anticipation rejections of dependent claim 6, dependent claim 6 stands or falls with independent claim 1. To the extent the examiner has rejected claim



6 as being obvious over Pilgrim, dependent claim 6 is allowable as being dependent on a base claim (i.e., claim 1) which carries a presumption that it is not obvious over the prior art (i.e., the examiner did not establish the required *prima-facie* case of obviousness of claim 1). See MPEP 2142: “The examiner bears the initial burden of factually supporting any *prima-facie* conclusion of obviousness.” That is, because claim 1 is not obvious over the prior art, claim 6, which depends from claim 1, cannot be obvious over the prior art.

Independent claim 10 is not anticipated by Pilgrim because Pilgrim fails to meet each and every limitation contained in independent claim 10. First, Pilgrim fails to disclose a frame having a lower plate and an upper plate that are positioned in generally parallel, spaced-apart relation. Pilgrim also fails to disclose that the lower and upper plates have a plurality of mounting locations provided thereon that define first and second component configurations. While the examiner asserts that Figure 11-13 of Pilgrim meets these limitations, Appellants are unable to discern in Figure 11-13 a frame having upper and lower plates, much less a frame that meets the other limitations of claim 10. Pilgrim’s lack of disclosure of the specific structural elements and configurations that are defined by claim 10 means that Pilgrim is a non-enabling reference, thus cannot anticipate claim 10. *Helifix, supra*.

The mounting locations provided in the upper and lower plates comprising the frame define first and second component configurations. In the first component configuration, first and second cartridge receiving devices are mounted to respective first and second sets of mounting locations. In the second component configuration, a third cartridge receiving device replaces the first and second cartridge receiving devices and is mounted to a third set of mounting locations so that a volumetric space occupied by the first and second cartridge receiving devices is substantially occupied by the third cartridge receiving device.

In supporting her rejections, the examiner asserts that the first component configuration

is the “combo drive” and that the second configuration is a single floppy drive. See page 7 of the office action. However, the examiner then goes on to say that the first and second cartridge receiving devices of claim 10 are met by a “3½ inch floppy drive” and a “5¼ floppy drive,” respectively, and that the third cartridge receiving device of claim 10 is met by the “old 360k floppy disk drive.” However, claim 10 requires that the first cartridge receiving device be mounted to “a first set of the plurality of sets of mounting locations” and that the second cartridge receiving device be mounted to “a second set of the plurality of sets of mounting locations.” The combo drive does not meet these limitations as both drives in the combo drive would be mounted to a single set of mounting locations, not respective first and second sets of mounting locations as required by claim 10. Because the Pilgrim reference fails to meet these limitations of claim 10, Pilgrim cannot anticipate claim 10.

If the 3½” and 5¼” floppy drives comprise separate drives, Pilgrim fails to meet the limitation of claim 10 that requires that a volumetric space occupied by the first and second cartridge receiving devices (in the first component configuration) is “substantially occupied” by the third cartridge receiving device (in the second component configuration). Stated another way, the volumetric space defined by separate 3½” and 5¼” floppy drives (when in the first component configuration) is not “substantially occupied” by the old 360k floppy drive” (when in the second component configuration). To the contrary, the old 360k floppy drive will occupy *only half* of the volumetric space as was occupied by the 3½” and 5¼” drives. Consequently, Pilgrim cannot anticipate claim 10.

With regard to the examiner’s alternative obviousness rejection of claim 10, claim 10 is not obvious over claim 10 in that Pilgrim fails to provide the suggest or incentive required to allow a person having ordinary skill in the art to modify the Pilgrim reference in the manner required by claim 10.

First, and as mentioned above, Pilgrim contains no teachings regarding the specific structural arrangement of the frame of claim 10, much less whether the frame contains upper and lower plates that are mounted in generally parallel, spaced-apart relation. Pilgrim also contains no teachings, or even suggestions, that would lead a person having ordinary skill in the art, and with no knowledge of the present invention, to provide the upper and lower plates with a plurality of sets of mounting locations to define the first and second configurations set forth in claim 10. To the contrary, because the device in Pilgrim is presumably functional in its current state, there is no need in Pilgrim, thus no suggestion or incentive, to modify the little structure disclosed in Pilgrim in the manner required by claim 10. As the Court of Appeals for the Federal Circuit made clear in *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000), a single prior art reference can only make obvious a pending patent claim if that single reference contains a suggestion or motivation to modify the teachings of the reference. Because Pilgrim fails to suggest the modifications to the frame (i.e., creating a frame having lower and upper plates having a plurality of sets of mounting locations provided thereon), Pilgrim cannot support an obviousness rejection of claim 10 under *In re Kotzab*, *supra*.

Pilgrim also fails to disclose or suggest a mounting arrangement wherein first and second cartridge receiving devices are mounted to respective first and second sets of mounting locations (for the case where the 3½” and 5¼” drives comprise the combination drive). If the drives comprise separate drives, then Pilgrim fails to disclose or suggest an arrangement wherein a third cartridge receiving device (in the second component configuration) occupies substantially the same volumetric space occupied by the first and second cartridge receiving devices (in the second component configuration). To the contrary, in Pilgrim, the third cartridge receiving device (e.g., the “old 360k drive”) would occupy only half the volumetric space. Pilgrim provides no suggestion or incentive (nor has the examiner identified any) that would lead a person having

ordinary skill in the art, and with no knowledge of the present invention, to so modify Pilgrim. Consequently, claim 10 is not *prima-facie* obvious over Pilgrim.

Dependent claims 11 and 13 stand or fall with independent claim 10.

With regard to the examiner's anticipation rejections of dependent claim 16, dependent claim 16 stands or falls with independent claim 14. To the extent the examiner has rejected claim 16 as being obvious over Pilgrim, dependent claim 16 is allowable as being dependent on a base claim (i.e., claim 14) which carries a presumption that it is not obvious over the prior art (i.e., the examiner did not establish the required *prima-facie* case of obviousness of claim 14). See MPEP 2142: "The examiner bears the initial burden of factually supporting any *prima-facie* conclusion of obviousness." Therefore, because claim 14 is not obvious over the prior art, claim 16, which depends from claim 14, cannot be obvious over the prior art.

**ISSUE 3: Whether claims 3, 12, and 18 are unpatentable under 35 U.S.C. §103(a) as being obvious over Pilgrim.**

### **The Examiner's Rejections**

The examiner rejected claims 3, 12, and 18 under 35 U.S.C. §103(a) as being obvious over Pilgrim in view of Menke *et al.*, U.S. Patent No 5,841,744 (Menke). These rejections are improper in that the examiner has not established the required *prima-facie* case of obviousness.

More specifically, claim 3 depends from claim 1. However, the examiner has not established the required *prima-facie* case of obviousness of claim 1 (i.e., the examiner did not reject claim 1 as being obvious). Therefore, claim 1 is presumed to be not obvious over the prior art. See MPEP 2142: "The examiner bears the initial burden of factually supporting any *prima-facie* conclusion of obviousness." Because claim 1 is presumed to be not obvious, claim 3, which

depends from claim 1, cannot be obvious. The same situation exists with respect to claim 18. That is, because the examiner has not established the required *prima-facie* case of obviousness of independent claim 14 (i.e., the examiner did not reject claim 14 under Section 103), claim 14 is presumptively not obvious over the prior art. Accordingly, claim 18 cannot be obvious over the prior art.

Claim 12 stands or falls with claim 10.

### CONCLUSION

The Pilgrim reference fails to meet each and every limitation of the pending claims, thus cannot anticipate any of the pending claims. In addition, Pilgrim is non-enabling as to the structure defined by the pending claims. Therefore, the Pilgrim reference cannot be used to support an anticipation rejection under Section 102. The examiner has also failed to establish the required *prima-facie* case of obviousness. Consequently, the claims remain presumptively non-obvious, thus allowable. Appellants respectfully request the Board to remove the rejections of claims 1-6 and 10-20.

Respectfully submitted,

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## **APPENDIX A**

1. A reconfigurable cartridge processing module for use in a data storage system, comprising:

a frame, said frame having a lower plate and an upper plate positioned in generally parallel, spaced-apart relation, said lower and upper plates of said frame having a plurality of sets of mounting locations provided thereon so that said frame defines a first component configuration and a second component configuration, the first component configuration comprising:

a first cartridge receiving device mounted to a first set of the plurality of sets of mounting locations provided on said frame so that said first cartridge receiving device is located at a first position within said frame; and

a second cartridge receiving device mounted to a second set of the plurality of sets of mounting locations provided on said frame so that said second cartridge receiving device is located at a second position within said frame, said first and second cartridge receiving devices together occupying a volumetric space within said frame, wherein said first and second cartridge receiving devices are located substantially between the upper and lower plates of said frame when said frame is in the first component configuration;

the second component configuration comprising a third cartridge receiving device mounted to a third set of the plurality of sets of mounting locations provided on said frame, said third cartridge receiving device occupying substantially the same volumetric space within said frame as is occupied by said first and second cartridge receiving devices in said first component configuration, wherein said third cartridge receiving device is located substantially between the upper and lower plates of said frame when said frame

is in the second component configuration.

2. The reconfigurable cartridge processing module of claim 1, wherein said first cartridge receiving device comprises a half-width cartridge read/write device.

3. The reconfigurable cartridge processing module of claim 1, wherein said second cartridge receiving device comprises a cartridge storage magazine.

4. The reconfigurable cartridge processing module of claim 1, wherein said third cartridge receiving device comprises a full-width cartridge read/write device.

5. The reconfigurable cartridge processing module of claim 1, wherein the second position is located adjacent the first position so that said second cartridge receiving device is located adjacent said first cartridge receiving device when said frame is in the first component configuration.

6. The reconfigurable cartridge processing module of claim 1, wherein the second position is located alongside the first position so that said second cartridge receiving device is located alongside said first cartridge receiving device when said frame is in the first component configuration.

7. Cancelled

8. Cancelled

9. Cancelled

10. A reconfigurable cartridge processing module for use in a data storage system, comprising:

a frame, said frame having a lower plate and an upper plate positioned in generally parallel, spaced-apart relation, said lower and upper plates of said frame having a plurality of sets of mounting locations provided thereon so that said frame defines a first component configuration and a second component configuration, the first component configuration comprising:

a first cartridge receiving device mounted to a first set of the plurality of sets of mounting locations provided on said frame so that said first cartridge receiving device is located at a first position within said frame; and

a second cartridge receiving device mounted to a second set of the plurality of sets of mounting locations provided on said frame so that said second cartridge receiving device is located at a second position within said frame, the second position being located adjacent the first position so that said second cartridge receiving device is located alongside said first cartridge receiving device, wherein said first and second cartridge receiving devices are located substantially between the upper and lower plates of said frame when said frame is in the first component configuration;

the second component configuration comprising a third cartridge receiving device mounted to a third set of the plurality of sets of mounting locations provided on said frame, said third cartridge receiving device in said second component configuration



substantially replacing said first and second cartridge receiving devices in said first component configuration and vice-versa, so that a volumetric space occupied by said first and second cartridge receiving devices in said first component configuration is substantially occupied by said third cartridge receiving device in said second component configuration and vice-versa, wherein said third cartridge receiving device is located substantially between the upper and lower plates of said frame when said frame is in the second component configuration.

11. The reconfigurable cartridge processing module of claim 10, wherein said first cartridge receiving device comprises a half-width cartridge read/write device.

12. The reconfigurable cartridge processing module of claim 10, wherein said second cartridge receiving device comprises a cartridge storage magazine.

13. The reconfigurable cartridge processing module of claim 10, wherein said third cartridge receiving device comprises a full-width cartridge read/write device.

14. A reconfigurable cartridge processing module for use in a data storage system, comprising:

a frame, said frame having a lower plate and an upper plate positioned in generally parallel, spaced-apart relation, said lower and upper plates of said frame having a plurality of sets of mounting locations provided thereon so that said frame defines a first component configuration and a second component configuration, the first component configuration comprising:

first cartridge receiving means mounted to said frame for receiving at least one data cartridge; and

second cartridge receiving means mounted to said frame for receiving said at least one data cartridge, wherein said first and second cartridge receiving means are located substantially between the upper and lower plates of said frame when said frame is in the first component configuration;

the second component configuration comprising third cartridge receiving means mounted to said frame for receiving said at least one data cartridge, said third cartridge receiving means in said second component configuration replacing said first and second cartridge receiving means in said first component configuration and vice-versa so that a volumetric space occupied by said first and second cartridge receiving means in said first configuration is substantially occupied by said third cartridge receiving means in said second configuration and vice-versa, wherein said third cartridge receiving means is located substantially between the upper and lower plates of said frame when said frame is in the second component configuration.

15. The reconfigurable cartridge processing module of claim 14, wherein said second cartridge receiving means is mounted adjacent said first cartridge receiving means when said frame means is in the first component configuration.

16. The reconfigurable cartridge processing module of claim 14, wherein said second cartridge receiving means is mounted alongside said first cartridge receiving means when said frame means is in the first component configuration.

17. The reconfigurable cartridge processing module of claim 14, wherein said first cartridge receiving means comprises cartridge read/write means for reading data from and writing data to said at least one data cartridge.

18. The reconfigurable cartridge processing module of claim 14, wherein said second cartridge receiving means comprises cartridge storage magazine means for storing said at least one data cartridge.

19. The reconfigurable cartridge processing module of claim 14, wherein said third cartridge receiving means comprises cartridge read/write means for reading data from and writing data to said at least one data cartridge.

20. A method, comprising:

providing a frame having a lower plate and an upper plate positioned in generally parallel, spaced-apart relation, said lower and upper plates of said frame having a plurality of sets of mounting locations thereon;

defining a first component configuration by mounting a first cartridge receiving device to a first set of the plurality of sets of mounting locations provided on said frame and by mounting a second cartridge receiving device to a second set of the plurality of sets of mounting locations provided on said frame so that the second cartridge receiving device is located adjacent the first cartridge receiving device, wherein said first and second cartridge receiving devices are located substantially between the upper and lower plates of said frame when said frame is in the first component configuration; or, in the alternative,

defining a second component configuration by mounting a third cartridge receiving device to a third set of the plurality of sets of mounting locations provided on said frame, said third cartridge receiving device in the second component configuration substantially replacing said first and second cartridge receiving devices in the first component configuration and vice-versa, so that a volumetric space occupied by said first and second cartridge receiving devices in the first component configuration is substantially occupied by said third cartridge receiving device in the second component configuration and vice-versa, wherein said third cartridge receiving device is located substantially between the upper and lower plates of said frame when said frame is in the second component configuration.

## **APPENDIX B**

### **Reference Relied on By Examiner in the Office Action**

Copies of the following reference are attached hereto for the Board's convenience:

1. Pilgrim, *Build Your Own 486/486DX*, McGraw-Hill, Inc., New York, 1995.
2. Menke *et al.*, U.S. Patent No. 5,841,744, issued November 24, 1998, entitled "Device for Playing, Recording, and Issuing Discs."